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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,902	04/02/2001	Mark A. Harper	10003780-1	1593

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DIVINE, LUCAS

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/824,902

Applicant(s)

HARPER ET AL.

Examiner

Lucas Divine

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-38.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

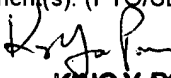
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Attachment.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


KING Y. POON
PRIMARY EXAMINER

Attachment

1. Applicant's arguments filed 8/12/05 have been fully considered but they are not persuasive.
2. With respect to applicant's argument on the bottom paragraph of page 8 that "**Sakuma does not disclose providing a sample by overlaying a sample window over a portion of the document.**"

In reply, it is clear that Sakuma (US 5663750) teaches estimating ink consumption based on a sample of the document, namely the amount of ink for a character as mentioned in the cited lines of the final rejection (e.g. col. 4 line 63 – col. 5 line 2). Applicant contends that the selection of a sample character (Examiner claims the window of a character) as a portion of the document does not include 'overlaying a sample window over a portion'. Examiner looks to applicant's specification for clarification of what 'overlaying a sample window over a portion' entails. Page 6, lines 21-26 discuss the sample window being overlaid in step 406. This discussion states that reading data out of a buffer to create an area of known size, less than the total anticipated size of the printed document is 'overlaying a sample window over a portion'. The window thus appears to be an area of known size, less than the total size, that is used as the sample. Sakuma reads a character worth of data (known size) which is less than the total anticipated size of the printed document. Thus, the Sakuma reference teaches the limitations of the claim as read in light of the specification.

Applicant further states what Sakuma teaches in the paragraph and then states at the bottom of page 8 that 'clearly, the character or page estimation method disclosed in Sakuma is not the same as the Applicant's overlaying a sample window' without giving a clear argument as

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to how the overlaying a sample window over a document of the applicant is technically different because it appears that the functions of both Sakuma and the claimed language, as read in light of the specification, are the same.

3. With respect to applicant's argument on page 10 that Motamed (US 2002/0060801) teaches away from Sakuma and therefore the references cannot be combined.

In reply, Examiner suggests the addition of the thumb RIP of Motamed discussed in paragraphs 12 and 27 to the system of Sakuma for additional consumption prediction and faster bit conversion that uses less system resources (While Sakuma teaches a system for predicting how much of a consumable the print job will take up, including one method of rasterizing the whole document [col. 4 lines 44-59], Sakuma does not specifically teach providing low resolution analysis with respect to the consumable requirements. Motamed teaches providing low level resolution analysis of a task to estimate toner consumption (paragraphs 0012 and 0027). It would have been obvious to one of ordinary skill in the art that providing two separate ways to predict toner consumption in a system would be preferable to only using one way. The motivation for doing so would be to more accurately predict consumable usage. This could be done a number of ways. By having two methods of prediction, the estimates could be averaged or compared to gain a more accurate number. For example, if one of the prediction methods was way off (let's say the character grabbed by the window is a period [.] , then the prediction of consumable for the job maybe way off), the other might be closer and would prevent misjudgments of toner prediction, and visa versa. Other ways of using two prediction methods as advantageous over just one are known in the art. Further, as stated above, Sakuma already teaches a method for creating a bit map of a job to predict toner estimation (col. 4 lines 40-59).

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Thus, the low level rip could be beneficial to the system of Sakuma by providing a faster bit conversion process that uses less system resources [Motamed paragraph 0012].)

Since the combination is not the whole system of Sakuma and the whole system of Motamed and only a well-known, advantageous feature of Motamed added to the ink ejection device of Sakuma, the arguments as to the other operations of Motamed not in the combination are moot.

4. With respect to applicant's arguments on page 11 that the references cannot be combined due to improper hindsight.

In reply, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

1) Examiner gives multiple motivations for combining (more accurate consumable prediction and faster bit conversion and using less resources).

2) The addition of Motamed further aids in the main object of Sakuma, which is to provide an ink ejection device capable of properly continuing printing even if remaining ink amount is small (col. 1 lines 59-61). This is done by ink estimation as discussed in cited lines and throughout figures, including using calculation means for calculating predicted usage (see col. 2). Therefore, the more accurate this process, the more Sakuma achieves the cited objective.

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Improving a cited objective of an invention with advantageous technology would have been obvious to one of ordinary skill in the art.

3) The addition of the feature of Motamed is very similar to features already in Sakuma. Sakuma teaches rasterizing for prediction of consumption in col. 4 lines 40-59. Motamed includes a similar function but does it faster and using less resources.

For these reasons, and others as seen from the references, the prima facie case of obviousness is proper and is maintained.


KING Y. POON
PRIMARY EXAMINER